

REMARKS

Claims 1-18 are pending in the application with Claims 1, 6 and 11 as the independent claims. The Examiner objected to the declaration filed under 37 CFR 1.131 as being insufficient to establish reduction to practice, conception and diligence. The Examiner rejected Claim 2 under 35 U.S.C. §112, second paragraph, for indefiniteness. Under 35 U.S.C. §103(a), the Examiner rejected the following claims: Claims 1-2 and 6-7, as being unpatentable over U.S. Publication No. 2004/0242243 to *Luis* in view of U.S. Publication No. 2003/0120553 to *Williams*; Claims 3-5 and 8-10, as being unpatentable over *Luis* in view of *Williams*, and further in view of U.S. Publication No. 2002/0107011 to *Mazzarella et al.* (hereinafter *Mazzarella*); Claim 11, as being unpatentable over *Luis* in view of U.S. Publication No. 2003/0134660 to *Himmel et al.* (hereinafter *Himmel*); and Claims 12-14, as being unpatentable over *Luis* in view of *Himmel*, and further in view of *Mazzarella*.

Reconsideration of this Application is respectfully requested.

It is gratefully acknowledged that Claims 15-18 were objected to as being independent upon rejected base Claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

Regarding the §112 rejection of Claim 2, the Examiner asserted this same rejection in the Office Action of April 3, 2006. Applicant addressed this rejection in the response of June 30, 2006. However, the Examiner reasserted the same rejection without any explication as to why the amendment of Claim 2 and accompanied arguments did not obviate the rejection. The same arguments presented in the last response are reproduced here for the Examiner's edification.

As articulated in the last response, the Examiner believes that the mobile communication system comprises more than the claimed one subscriber management database for storing the service change information. Claim 2 has been amended, as previously submitted, to obviate this

rejection. Specifically, Claim 2 as amended recites “a subscriber management database on every communication network formed by each service provider”. It is respectfully submitted that this amendment cures the rejection. Accordingly, withdrawal of the Examiner’s §112 rejection of Claim 2 or a clear explanation as to why the amendment and arguments are insufficient to overcome the rejection is respectfully requested

As to the rejections under §103, the Applicant respectfully traverses these rejections based on the arguments below. In order for the Examiner to establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Neither Luis, nor Williams recite “a first mobile switching center (MSC#1) that receives a call request signal (CRS) including information on calling and called mobile terminals (MT1 and MT2, respectively),” as taught by the present invention.

As a preliminary matter, regarding the objection to the declaration filed under 37 CFR 1.131 to overcome Luis in the statement of insufficiency, the Examiner only addressed Claim 1. Therefore, Applicant’s response only addresses Claim 1. In support of the objection, the Examiner stated that the evidence submitted fails to show at least three (3) elements among them:

(1) regarding Claim 1 “determining an initial service provider of a called terminal from the called terminal information, and transmitting the call request to a communication network formed by the determined initial service provider of the called terminal.” The translation of the Korean application proffered as evidence recites: “detecting an initial service provider of a called terminal from the called terminal information, and transmitting the call request to a communication network formed by the determined initial service provider of the called terminal.” There is no difference between these two elements.

(2) “determining a changed service provider of the called terminal based on the called terminal information included in the call request signal transmitted from the first MSC.” The translation of the Korean application provided as evidence recites: “detecting a changed service provider of the called terminal based on the called terminal information included in the call request signal transmitted from the first MSC.” The difference between the two recitations that

can be discerned is the use of the words: “determining” and “detecting”. In this context, using the plain meaning of the two words, they are synonymous. Determine means “to establish or ascertain definitely, as after investigation or calculation” and detect means “to discover or ascertain the existence, presence or fact of.”

(3) “transmitting the call request signal received from the second MSC to the called terminal so that the called terminal can communicate with the calling terminal over a communication network formed by the changed service provider.” The translation of the Korean application proffered as evidence recites: “transmitting the call request signal received from the second MSC to the called terminal so that the called terminal can communicate with the calling terminal over a communication network formed by the changed service provider.” There is no difference between these two elements. Accordingly, the Examiner is incorrect in the determination of insufficiency of the evidence.

As for conception of the invention, the Applicant respectfully disagrees with the Examiner’s assertion that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the *Luis* reference. Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill. *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). The invention disclosure provided as Exhibits A and B at the time of filing the 131 affidavit clearly show that every claimed limitation was known to the inventor at least before January 7, 2003 which is earlier than the effective filing date of the *Luis* reference. *Hybritech Inc. v. Monoclonal Antibodies Inc.* 802 F.2d 1367, 1676, 231 USPQ 81, 87 (Fed. Cir. 1986). In contradistinction to the Examiner’s assertion, conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention as it is hereafter to be applied in practice. *Id.* The invention disclosure amply shows that a definite and permanent idea of the complete and operative idea of the invention was etched in the mind of the inventor. Accordingly, the Examiner is incorrect in the determination of insufficiency of the evidence.

Regarding the rejections under §103, Claim 1 sets forth a first mobile switching center

(MSC#1) that receives a call request signal (CRS) including information on calling and called mobile terminals (MT1 and MT2, respectively). From the CRS, MSC#1 determines MT2's initial service provider (SP1), and transmits the CRS to a first network (CN1). Then, a second mobile switching center (MSC#2) determines MT2's new service provider (SP2) from the CRS, and transmits the CRS to a second network (CN2) formed by SP2. A third mobile switching center (MSC#3) transmits the CRS to MT2 so that MT1 and MT2 can communicate over CN2. Claim 6 has similar recitations in a method step format, without specifically reciting the first, second and third MSC's.

In sharp contrast, the Examiner cites *Luis*, which is directed to number portability for a GSM system. *Luis* only discloses two mobile switching centers in Figure 1, which is relied on by the Examiner, and does not teach three such centers as Claim 1 recites. The Examiner cites GMSC1 as allegedly reading on the MSC#2 of Claim 1. However, the GMSC1 in *Luis* fails to determine a changed service provider of the called terminal (MT2), and fails to transmit the CRS to a CN2, as called for in Claim 1. Instead, in *Luis*, GMSC1 requests routing data for the called subscriber from a number portability database (NPDB1) by sending a message S-101, and it is the NPDB1 that checks the ISDN of the called subscriber to determine to which network the number belongs (see [0008], lines. 1-13). Moreover, in *Luis*, the NPDB1 relays routing information including a new destination network of the mobile terminal, back to the GMSC2 in a second message S-102b (see [0008], lines. 23-30). Worse yet, *Luis* teaches that upon receipt of the answer for the received send routing information from the NPDB1 (all of which would be determined in the MSC#2 of Claim 1, by contrast), the GMSC1 transmits a third message S-103a to a transit network, and not to a network formed by the determined service provider, as called for in Claims 1 and 6 (see [0008], lines. 37-41). From there, the transit network forwards a fourth message S-103b to the destination network. In other words, in *Luis*, the message S-101 initially sent from GMSC1 to NPDB1 is wholly different from the message S-103b that is ultimately sent from the transit network to the destination network. Clearly, *Luis* fails to teach receiving the CRS, determining an SP2 therefrom and transmitting the CRS to a CN2, formed by the determined service provider, as recited in Claims 1 and 6.

Likewise, *Luis* fails to teach transmitting the CRS (which is received by MSC#3 from the

MSC#2 in Claim 1) to the called terminal, as recited in Claims 1 and 6. *Luis* simply cannot teach this recitation because the message S-101 (which is the closest *Luis* teaches to the CRS in Claims 1 and 6) is not transmitted by a third MSC, as the Examiner alleges. In fact, it is a fifth message S-105 that instead is transmitted in paragraph [0010], relied on by the Examiner. Simply put, the CRS in Claims 1 and 6 does not change; however, the message (S-101, S-102...) in *Luis* changes at least five times before message S-105 finally is relayed to home location register 2. Furthermore, the only transmitting performed by the GMSC2 (alleged by the Examiner as reading on the MSC#3 in Claim 1) is a message S-104 to NPDB2, which fails to meet transmitting the CRS to the called terminal, as recited in Claim 1.

In addition, the Examiner concedes that *Luis* fails to teach the recitations of the MSC#1 in Claim 1, and paragraph a) in Claim 6, specifically the receiving, determining and transmitting recitations. Applicant respectfully disagrees with the Examiner's allegation that these recitations would have been obvious. The Examiner has provided no art to teach these recitations, and *Luis* fails to fairly suggest these recitations. *Williams*, the secondary reference, fails to cure any of the above stated deficiencies in *Luis*. For at least the foregoing reasons, the Applicant believes the §103(a) rejection of Claims 1-2 and 6-7 should be withdrawn.

Regarding independent Claim 11, Himmel does not cure the deficiencies of Luis as articulated above. For at least the foregoing reasons, the Applicant believes the §103(a) rejection of Claim 11 should be withdrawn.

Independent Claims 1, 6 and 11 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-5, 7-10 and 12-18, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2-5, 7-10 and 12-18 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1-18, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul J. Farrell", written over the printed name.

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